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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/723,521	11/26/2003	Ron Ben-Natan	GRD03-01	8680
58406 7590 02/04/2008 BARRY W. CHAPIN, ESQ. CHAPIN INTELLECTUAL PROPERTY LAW, LLC WESTBOROUGH OFFICE PARK 1700 WEST PARK DRIVE WESTBOROUGH, MA 01581			EXAMINER KIM, PAUL	
			ART UNIT 2161	PAPER NUMBER
			MAIL DATE 02/04/2008	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

mn

Office Action Summary	Application No. 10/723,521	Applicant(s) BEN-NATAN, RON	
	Examiner Paul Kim	Art Unit 2161	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 November 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8, 11-30 and 33-46 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-8, 11-19, 20-23, 24, 40, 42 and 44-46 is/are allowed.
- 6) ☒ Claim(s) 41 and 43 is/are rejected.
- 7) ☒ Claim(s) 25-30 and 33-39 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/ are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This Office action is responsive to the following communication: Amendment filed on 19 November 2007.
2. Claims 1-8, 11-30, and 33-46 are pending and present for examination.

Specification

3. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter, specifically, claim 41. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required:

In this instance, Applicant has failed to provide antecedent basis for the claim terminology "computer program product" in claim 41. Therefore, the question becomes whether non-statutory embodiments would be fairly conveyed to one of ordinary skill given the terminology utilized. In this instance, it would appear to be reasonable to interpret "communication media" as fairly conveying signals and other forms of propagation to one of ordinary skill.

Claim Objections

4. Claims 25-30 and 33-39 are objected to because of the following informalities: While independent claim 24 is directed to a "computer data security filter device," it is noted that claims 25-30 and 33-39 are directed to a "security filter." Appropriate correction is required.

Claim Rejections - 35 USC § 101

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. **Claim 41** is rejected under 35 U.S.C. 101 because it fails to fall within a statutory category of invention. It is directed to a "computer program product" which may be reasonably interpreted to include conveying signals and other forms of propagation to one of ordinary skill.

The meaning of "program" as disclosed on page 22 of the Specification, covers non-statutory embodiments which improperly include "baseband signaling or broadband signaling techniques, as in an electronic network such as the Internet or telephone modem." For the aforementioned reasons discussed in the objections to the Specification, which are incorporated herein, the claimed invention does not properly cover only statutory subject matter (e.g., conveying signals and other forms of propagation) because the disclosed program code being transmitted across the transmission media cannot be executed by any known processor. Therefore, the transmitted program code lacks functional capability because, absent execution, it cannot cause any of the claimed operations to be performed, and so, in the state of being transmitted, the program code represents nothing more than non-functional descriptive material. Moreover, under 35 U.S.C. § 101, signals propagating through space, radio waves, and infrared signals are not permissible "articles of manufacture" because they have no tangible embodiment.

7. **Claim 43** is rejected under 35 U.S.C. 101 because it fails to fall within a statutory category of invention. It is noted that claim 43 is directed to a "data security filter device" with the "means for" a number of recited method steps which would suggest to one of ordinary skill that all said means for functions may be reasonably implemented as software routines. Even though Applicant has invoked the rebuttable presumption that 35 U.S.C. 112, 6th paragraph applies in the claim interpretation of the means for functions, corresponding "structure" in the disclosure is not automatically and inherently limited to hardware-inclusive embodiments. It is entirely possible for the corresponding disclosed "means" to cover an embodiment of software alone. Accordingly, said means for functions qualify as software per se and fail to fall within a statutory category of invention.

Allowable Subject Matter

8. Claims 1-8, 11-19, 20-23, 24, 40, 42, and 44-46 are allowed.

Conclusion

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul Kim whose telephone number is (571) 272-2737. The examiner can normally be reached on M-F, 9am - 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Apu Mofiz can be reached on (571) 272-4080. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Paul Kim
Patent Examiner, Art Unit 2161
TECH Center 2100



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SUPERVISORY PATENT EXAMINER